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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,281	08/20/2003	Christian Spicler	36287-03801	5799
27171 7590 12/24/2008 MILBANK, TWEED, HADLEY & MCCLOY 1 CHASE MANHATTAN PLAZA NEW YORK, NY 10005-1413				
EXAMINER				
RANKINS, WILLIAM E				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
12/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/644,281

**Applicant(s)**

SPIELER ET AL.

**Examiner**

WILLIAM E. RANKINS

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-20, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 08/20/2003 and 10/09/2003 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Status of Claims***

Claims 1-25 are pending in this application. Claims 1, 8, 20 and 22-24 are amended. Claim 25 is new and claim 21 is canceled.

### ***Response to Arguments***

1. Applicant's arguments, see pgs. 9-10, filed 10/01/2008, with respect to claim 12 have been fully considered and are persuasive. The 101 rejection of 05/29/2008 has been withdrawn.
2. Applicant's arguments, see pgs. 10-11, filed 10/01/2008, with respect to claim 8 have been fully considered and are persuasive. The 112 rejection of 05/29/2008 has been withdrawn.

3. Applicant's arguments, see pgs. 11-15, filed 10/01/2008, with respect to claims 1-20 and 22-25 have been fully considered and are persuasive. The 103 rejection of 05/29/2008 has been withdrawn.

***Allowable Subject Matter***

1. Claims 22-23 are allowed.
2. The following is an examiner's statement of reasons for allowance: After a thorough search of the prior art and consideration of the arguments presented, the examiner does not find that the prior art discloses, either alone or in combination the computer readable medium and programmed computer for managing collateralized obligations comprising;

identifying a plurality of debt obligations according to terms of an asset management agreement, which together constitute a single debt index;

allowing linking of a first investment deal to the single debt index according to terms of the asset management agreement;

allowing linking of a second investment deal to the single debt index according to terms of the asset management agreement;

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. The following is a statement of reasons for the indication of allowable subject matter: After a thorough search of the prior art and consideration of the arguments presented, the examiner does not find that the prior art discloses, either alone or in combination the method for managing collateralized obligations comprising;

identifying a plurality of debt obligations according to terms of an asset management agreement, which together constitute a single debt index;

allowing linking of a first investment deal to the single debt index according to terms of the asset management agreement;

allowing linking of a second investment deal to the single debt index according to terms of the asset management agreement;

4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

A review of the claims and updated search necessitated the rejections below.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-20, 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the present case, the claims are not tied to another statutory class such as an apparatus. Based on Supreme Court precedent (*Diamond V. Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) a 101 process must be tied to another statutory class or transform underlying subject matter to a different stat or thing, If neither of these requirements is met by the claim, the method is not a patent eligible process under 101and should be rejected as being directed to non-statutory subject matter.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/  
Examiner, Art Unit 3696  
12/18/2008

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/Daniel S Felten/

Primary Examiner, Art Unit 3696